

REMARKS

Applicant has carefully reviewed the Office Action mailed April 2, 2007 and offers the following remarks.

The Rejection Under 35 U.S.C. § 101

Claims 1-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Patent Office states that the method steps of claim 10 and the elements of claim 1 are disclosed by the specification and claimed in claim 19 as computer instructions. The Patent Office goes on to argue that since “there are no practical applications claimed, i.e., no physical transformations take place, nor a useful, concrete, and tangible result being produced, the claims are non-statutory” (Office Action mailed April 2, 2007, p. 2).

Applicant respectfully traverses.

Per the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” published in the Official Gazette on November 22, 2005 (hereinafter “Guidelines”), the Examiner must ascertain the scope of the claim to determine whether it covers either a court recognized judicial exception to patentable subject matter under 35 U.S.C. § 101 or a practical application of Section 101 (i.e., abstract ideas, laws of nature, and natural phenomena). (See Guidelines, Section IV.C). For claims including such excluded subject matter to be eligible, the claims must be for a practical application of the abstract idea, law of nature, or natural phenomenon (quoting *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (“application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection”); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it “has no substantial practical application”)). (See Guidelines, Section IV.C.2).

Thus, according to the Guidelines, “[t]o satisfy section 101 requirements, the claim must be for a practical application of the Sec. 101 judicial exception, which can be identified in various ways: [1] The claimed invention “transforms” an article or physical object to a different state or thing; [2] [t]he claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.” (See Section IV.C.2). In determining whether a claim provides a practical application that produces a useful, tangible, and concrete result, the Examiner must consider certain factors. (See Guidelines, Section IV.C.2.b).

With respect to the “useful result” factor, the USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial, and (iii) credible. MPEP § 2107. The rejected claims do provide a specific, substantial, and credible utility. The present invention, according to claim 1, recites a system comprising:

- a) an interface adapted to facilitate media communications; and
- b) a control system associated with the interface and providing a combined user agent, which is adapted to:
 - i) represent a telephone and a computing device as a single multimedia device capable of supporting voice and media sessions;
 - ii) communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device; and
 - iii) communicate with the computing device to establish a media session between the computing device and another media-capable device,
wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions.

First of all, claim 1 is to a system. Claim 1 recites an interface and a control system that provides a combined user agent. These are specific structural elements which are not abstract ideas and fall squarely within the statutory definition of 35 U.S.C. § 101 as a machine, manufacture, or composition of matter. Moreover, the control system of claim 1 is to “represent a telephone and a computing device as a single multimedia device capable of supporting voice and media sessions,” “communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device,” and “communicate with the computing device to establish a media session between the computing device and another media-capable device.” At the very least, communicating with a telephony switch to establish a connection between a telephone and a voice capable device, and communicating with a computing device to establish a media session between the computing device and a media-capable device show that the claimed invention has a specific, substantial, and credible utility.

With respect to the “tangible result” factor, the Guidelines provide that “[t]he tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.” (See Guidelines, Section IV.C.2.b). However, “the tangible requirement does require that the claim must recite more than a Sec. 101 judicial exception, in that the process claim must set forth a practical application of that Sec. 101 judicial exception to produce a real-world result.” *Id.* The rejected claims do produce a tangible result, and thus satisfy this factor. These claims provide a system and method where a combined user agent does four tangible things. The combined user agent: (1) represents a telephone and a computing device as a single multimedia device, (2) communicates with a telephony switch to establish a connection with the telephone through the telephony switch to facilitate a voice session with another voice-capable device, (3) communicates with a computing device to establish a media session between the computing device and another media-capable device, and (4) appears to network devices as a multimedia client supporting voice and multimedia sessions and interacts with the telephony switch and the computing device to facilitate the voice and media sessions.

With respect to the “concrete result” factor, the Guidelines provide that “the process must have a result that can be substantially repeatable or the process must substantially produce the same result again” and thus “concrete.” (See Guidelines, Section IV.C.2.c). Clearly, claims 1-27 recite a process that is repeatable and thus concrete. The steps in the process are definite, deliberate, and are repeatable.

Thus, in summary, the rejected claims 1-27 do produce a real world result and thus are proper patentable subject matter under 35 U.S.C. § 101. The claims provide a practical application that produces a useful, tangible, and concrete result, as required by the Guidelines. The combined user agent of the claimed invention represents a telephone and a computing device as a single multimedia device and communicates with a telephony switch to establish a connection with the telephone and the telephony switch to facilitate a voice session and communicates with a computing device to establish a media session between the computing device and another media-capable device. The practical real-world application is that a voice session and a media session are both established and the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media

sessions. Since the invention as claimed provides a practical application that produces a useful, tangible, and concrete result, the claimed invention is patentable subject matter under 35 U.S.C. § 101.

The Rejection Under 35 U.S.C. § 102(e)

Claims 1-6, 9-15, 18-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,320,857 B1 to Tönnby et al. (hereinafter “Tönnby ‘857”). Applicant respectfully traverses. For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. The requirement that each and every element be disclosed in the manner claimed is a rigorous standard that the Patent Office has not met in this case.

The present invention is designed to provide a combined user agent (CUA) to act as an effective proxy for a telephone and multimedia device so that a network would perceive the two elements as a single device. In particular, claim 1 recites an interface adapted to facilitate media communication and a control system associated with the interface and providing a CUA, which is adapted to:

- i) represent a telephone and a computing device as a single multimedia device capable of supporting voice and media sessions;
- ii) communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device; and
- iii) communicate with the computing device to establish a media session between the computing device and another media-capable device,

wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions.

So, according to the present invention, the CUA performs the following steps: (1) the CUA represents a telephone and a computing device as a single multimedia device, (2) the CUA communicates with a telephony switch to establish a connection with the telephone through the telephony switch to facilitate a voice session with another voice-capable device, (3) the CUA communicates with a computing device to establish a media session between the computing

device and another media-capable device, and (4) the CUA appears to network devices as a multimedia client supporting voice and multimedia sessions and interacts with the telephony switch and the computing device to facilitate the voice and media sessions. Tonnby ‘857 fails to teach a CUA that performs these steps, and thus does not teach the claimed CUA.

The Patent Office alleges that the blocks 8 and 10 of Figure 4 of Tonnby ‘857 are the claimed CUA (Office Action mailed April 2, 2007, pp. 3-4). Block 8 is an Internet access server, or IP access server, which acts as an Internet gateway between the PSTN and the Internet (see Tonnby ‘857, col. 3, ll. 60-64). Block 10 is a telephony server, which provides a telephony service to users of the Internet (*Id.* at col. 3, ll. 64-67). The IP access server 8 and telephony server 10 of Tonnby ‘857 are not equivalent to the claimed CUA.

First of all, the IP access server 8 and the telephony server 10 cannot combine to be the claimed CUA. The CUA of the present invention is provided to represent a telephone supported by a circuit-switched telephony switch and a packet-based media device as an integrated group to other network entities. The CUA is configured to facilitate the necessary call signaling to establish and control a voice call via the telephony switch, as well as the session control signaling (Specification, paragraph 0004; see also Figures 1-4). The CUA is created to control packet-based multimedia sessions, as well as to control call signaling at a traditional telephony switch for a telephone and an associated multimedia device, such as a computer. The CUA can effectively establish multimedia sessions with the multimedia device and voice calls with the telephone (Specification, paragraph 0015; see also Figures 1-4). The CUA acts as a virtual agent for a computing device, such as a computer, which is capable of supporting multimedia sessions. The CUA also acts as an agent for a traditional telephony device, such as a telephone, which is supported by a telephony switch that is capable of providing circuit-switched communications between the telephone and other telephony devices (Specification, paragraphs 0016-0017; see also Figures 1-4). The IP access server 8 and telephony server 10 of Tonnby ‘857 do not act as the claimed CUA, which is a single agent.

Instead, the IP access server 8 and the telephony server 10 of Tonnby ‘857 are two separate elements with different purposes. In fact, Tonnby ‘857 states that the telephony server 10 is generally independent of the IP access server 8 (Tonnby ‘857, col. 4, ll. 24-25). The telephony server is connected to the IP access server 8 via a LAN (*Id.* at col. 4, ll. 27-30). Two devices connected by a LAN cannot be the claimed CUA, which is a single agent. Thus, the IP

access server 8 and the telephony server 10 cannot combine to be the claimed CUA. For this reason, Tonnby ‘857 does not teach each and every element of claim 1, and therefore does not anticipate claim 1.

Second, the IP access server 8 and the telephony server 10, alone or together, do not “represent a telephone and a computing device as a single multimedia device capable of supporting voice and media sessions,” as recited by claim 1. Tonnby ‘857 does disclose a telephone (e.g., telephones 1 and 6 in Figure 3, as well as personal computers 2 and 21 in Figure 4). However, the IP access server 8 and the telephony server 10, alone or together, do not represent either of the telephones 1 and 6 and either of the computers 2 and 21 together as a single multimedia device capable of supporting voice and media sessions. In fact, the IP access server 8 does not communicate directly with the telephones 1 and 6, or the computers 2 and 21. Since the IP access server 8 and the telephony server 10, alone or together, do not represent either of the telephones 1 and 6 and either of the computers 2 and 21 together as a single multimedia device capable of supporting voice and media sessions, Tonnby ‘857 fails to teach the claimed CUA. Accordingly, claim 1 is patentable for this additional reason.

Third, the IP access server 8 and the telephony server 10, alone or together, do not “communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device,” as recited in claim 1. Although Tonnby ‘857 arguably discloses a voice session being set up between the telephones of users A and B, the IP access server 8 and the telephony server 10 (which the Patent Office asserts is the claimed CUA) that communicate with a circuit-switched telephony switch do not establish a connection through the circuit-switched telephony switch to facilitate a voice session. Instead, in Tonnby ‘857, if user A on telephone 1 wishes to place a call while having an ongoing Internet session, user A enters a phone number to call on user A’s computer. A telephony application on the computer requests the telephony server 10 to place a call to the requested number (Tonnby ‘857, col. 6, ll. 4-15). However, this request and the requested phone number are sent to the telephony server 10 over the IP paths (*Id.* at col. 6, ll. 15-17). Moreover, upon connection, the speech information is exchanged using the IP paths (*Id.* at col. 6, ll. 21-24). Thus, Tonnby ‘857 does not disclose that the IP access server 8 and the telephony server 10 “communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a

voice session with another voice-capable device,” as recited in claim 1. Since Tonnby ‘857 does not teach each and every element of claim 1, it does not anticipate claim 1.

Fourth, Tonnby ‘857 fails to teach that the claimed CUA acts to “communicate with the computing device to establish a media session between the computing device and another media-capable device,” as recited in claim 1. The Patent Office states that the line 14 in Figure 3 shows an ongoing IP session and this is equivalent to the above claim limitation (Office Action mailed April 2, 2007, p. 4). Although the line 14 in Figure 3 does indicate an IP link, it does not equate to “a media session between the computing device and another media-capable device,” as recited in claim 1. In fact, the IP link 14 is just an Internet connection between user A’s computer 2 and the Internet 9 (see Tonnby ‘857, col. 4, lines 49-56). It is not a media session between a computing device and another media-capable device. Moreover, what the Patent Office has alleged is the claimed CUA – the IP access server 8 and the telephony server 10 – do not communicate with user A’s computer 2 to establish the IP link 14. For these reasons, it is clear that Tonnby ‘857 does not teach a CUA adapted to “communicate with the computing device to establish a media session between the computing device and another media-capable device,” as recited in claim 1. Claim 1 is thus not anticipated for this additional reason.

Finally, Tonnby ‘857 fails to teach wherein the CUA “appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions,” as recited in claim 1. The IP access server 8 and the telephony server 10 of Tonnby ‘857 do not appear to network devices as a single multimedia client. Moreover, as discussed above, the IP access server 8 and the telephony server 10 of Tonnby ‘857 do not interact with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions. Since Tonnby ‘857 does not teach this limitation of claim 1, it does not anticipate claim 1 for this additional reason.

Claims 2-6 and 9 depend from claim 1 and are not anticipated at least for the same reasons.

Claim 10 recites essentially the same element, albeit in method form. As such, claim 10 is not anticipated. Claims 11-15 and 18 depend from claim 10 and are not anticipated at least for the same reasons.

Claim 19 recites essentially the same element, albeit in a software format. As such, claim 19 is not anticipated. Claims 20-24 and 27 depend from claim 19 and are not anticipated at least for the same reasons.

Certain dependent claims require special mention. Claim 2 recites the additional limitation “wherein the combined user agent is further adapted to associate the connection and media session with one another.” Claims 11 and 20 have a similar limitation. The Patent Office cites to column 6, lines 25-29 and Figure 4 of Tonnby ‘857 as teaching this limitation, stating that Figure 4 shows links 14, 15, and 23 for ongoing IP sessions and voice (Office Action mailed April 2, 2007, p. 4). Applicant respectfully traverses. First of all, as discussed above, the IP session of Tonnby ‘857 is not equivalent to the claimed media session. Moreover, having ongoing IP and voice sessions is not equivalent to associating the voice connection and the media session with one another, as recited by the claims of the present invention. Column 6, lines 25-29 of Tonnby ‘857 merely indicate that user A can place outgoing calls or receive incoming calls while there is an ongoing IP session. There is nothing that suggests associating the calls with the IP session, as required by the claimed invention. Accordingly, Tonnby ‘857 fails to teach each and every limitation of claims 2, 11, and 20. Thus, claims 2, 11, and 20 are not anticipated for this additional reason.

Similarly, claim 3 recites the further limitation “wherein the combined user agent is further adapted to provide information associated with the connection to the computing device for use in an application associated with the media session.” Claims 12 and 21 have a similar limitation. The Patent Office cites to column 5, lines 50-60 of Tonnby ‘857 as allegedly teaching this limitation. The cited portion of Tonnby ‘857 merely discloses the situation where user A is in an Internet session and receives a notification of an incoming call and requests the telephony server 10 to redirect the call to a call handling agent. The call handling agent is connected to the telephony server 10 and the user’s computer, and may be a voice mail box or electronic secretary. However, there is nothing about the call handling agent or the cited passage which discloses that information associated with the voice connection is provided to the computing device for use in an application associated with the media session, as required by the claimed invention. Nothing is provided to the computer for use in an application associated with the IP session. Thus, Tonnby ‘857 does not teach each and every limitation of claims 3, 12, and 21. Accordingly, claims 3, 12, and 21 are not anticipated for this additional reason.

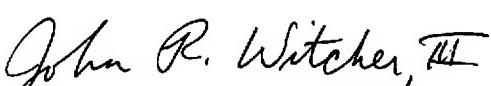
Claims 7, 8, 16, 17, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonnby in view of U.S. Patent No. 6,822,957 B1 to Schuster et al. (hereinafter "Schuster"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Claims 7 and 8 depend from claim 1. Claims 16 and 17 depend from claim 10. Claims 25 and 26 depend from claim 19. Thus, each of these dependent claims contains all of the limitations of the independent claim from which it depends. As explained above, Tonnby '857 does not teach each and every limitation of the independent claims. Nothing in Schuster cures these deficiencies of Tonnby '857. Since the references individually do not teach or suggest each and every claim element, the combination of references cannot teach or suggest each and every claim element. Since the combination does not teach or suggest each and every claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, claims 7, 8, 16, 17, 25, and 26 are allowable.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,
WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III
Registration No. 39,877
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: July 2, 2007
Attorney Docket: 7000-089